

REMARKS

I. Response to Objection to the Drawings

The Examiner has objected to the drawings because “the circular discs having the same diameter as the striking wheel must be shown or the feature(s) canceled from the claim(s).” *See* Office Action at ¶ 5. Claim 2 is amended to recite that “said circular discs has a diameter approximately equal to that of said striking wheel,” which is shown in the drawings as explained below.

In a previous Office Action (February 1, 2008), Claim 2 was rejected under § 112, first paragraph, as failing to comply with the written description requirement, with the Examiner noting: “There is no support for the scope of claim 2 as to a disc diameters that are not ‘equal’ but instead are more broadly ‘substantially equal’”. *See* February 1, 2008 Office Action at ¶ 5. In response to that Office Action, the Applicant deleted the limitation “substantially” in the hopes of facilitating prosecution. As a result of that limitation being deleted, the Examiner now asserts that the drawings fail to comply with 37 CFR 1.83(a). Therefore, the Applicant has restored the limitation by amending claim 2 (and claim 13) to recite that the circular discs have a diameter approximately equal to that of the strike wheel, and in doing so notes that this is supported by the specification. The specification teaches, “two circular discs 53, 54, each having a glossy circumferential surface and a diameter **approximately equal** to that of the striking wheel 52...” *See* USP 5,897,307 (col. 5, lines 27-29). Moreover, the drawings—namely, Figures 2, 3, and 4—show that the discs are approximately equal in diameter to the striking wheel.

Applicant respectfully requests that the objection to the drawings be withdrawn.

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III. Response to Rejection Under 35 U.S.C. § 103

A. The Claims are Patentable over Sher

Claims 2, 8, and 13 are rejected under § 103 as being unpatentable over U.S. Patent No. 5,769,625 to Sher (“Sher”). *See* Office Action at ¶ 5. Specifically, the Examiner states:

Sher, as discussed above, discloses the invention as claimed with the exception of showing the discs having a diameter slightly larger than the striker wheel (Figure 5) instead of equal to the striker wheel.

The courts have held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would **not perform differently** than the prior art device, the claimed device was not patentably distinct from the prior art device. (In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), also MPEP 2144.04).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher apparatus by making the striking wheel [*sic*, discs] have a diameter equal to the striking wheel as a matter of obvious design choice.

See Office Action at ¶ 9 (emphasis added). Applicant respectfully traverses the rejection.

In the claims as amended, the lighter of the present invention comprise circular discs that have a diameter approximately equal to that of the strike wheel. By contrast, the discs (722) in Figure 5 of Sher have a diameter that is significantly larger than that of the strike wheel (720). This difference would not have merely been a “matter of obvious design choice” since it is a difference that is critical to the performance of the respective lighters. In other words, unlike in the cases cited by the Examiner, the claimed lighter of the present invention performs differently from Sher because its circular discs have a diameter approximately equal to that of the strike wheel and Sher does not.

In the claimed lighter of the present invention, the glossy circular discs (53, 54) function to displace the downward actuating force from the user’s thumb. To put it simply, when the

thumb is pressed down on the strike wheel (52), not all of the force will be translated directly to the strike wheel (52); some of the force will be translated to the circular discs (53, 54). Because the circular discs (53, 54) are glossy and have a diameter approximately equal to that of the strike wheel (52), this force is displaced (*i.e.* it is not transferred to the strike wheel (52)). This has the effect of making it harder to actuate the strike wheel (52). Hence, the underlying safety design concept is based on the fact that children will have more difficulty *exerting the greater force necessary to actuate the strike wheel (52)*. This is explained by Sher in the specification:

In order to fill the gaps between two sides of the striking wheel 52 and the two bent-edge members 63, 64 and to provide a better striking contact with an adult's thumb by increasing the contacting area, two circular discs 53, 54, each having a glossy circumferential surface and a diameter approximately equal to that of the striking wheel 52, are integrally formed at the two sides of the striking wheel 52....

Accordingly, the striking wheel 52 of the disposable lighter of the present invention is arranged to match the curvature of the curved corners 631, 641 of the wind shield 60....Furthermore, in the past, an underage kid can easily ignite a conventional gas lighter by rubbing the protruding driving wheel A32, A33, as shown in FIG. 1, with limited force. However, **the underage kid is prevented to ignite the present invention since his or her weak minor's thumb force is unable to apply a sufficient striking force to the striking wheel 52 of the present invention without any adult supervision.**

See USP 5,897,307 (col. 5, lines 24-53 (emphasis added)).

By contrast, in Sher the discs (722) have a diameter that is significantly larger than that of the strike wheel (720). The effect of this is not to increase the force necessary for actuating the strike wheel. Rather, the purpose of making the disc (722) much bigger than the strike wheel (720) is to *inhibit access* to the strike wheel (720). Because the discs (722) have a diameter that is significantly larger than that of the strike wheel (720), the strike wheel (720) is *recessed* between the discs (722) such that there is less contact between the thumb and the wheel. This

makes it harder for children to make contact with the strike wheel (720) because children's thumbs have less "pulp." Sher teaches:

[T]he annular **recessed** center region of the lighter's striker wheel is sufficiently **deep enough to prevent a child's finger from being inserted between the annular unrecessed lateral portions**. However, this center region is still shallow enough to allow the pulp of an adult's finger to touch and grip the annular recessed center region and to thereby make turning the striker wheel easier for the adult.

See Sher at 2:23-31 (emphasis added). Sher goes on to explain:

The recessed center portion 719 is shallow enough to allow the pulp of an adult's finger to touch and to grip the annular recessed center portion, yet is deep enough to prevent the finger of a child from contacting the annular recessed center portion. In being able to grip the proturbances 719A of annular recessed center portion 719, the pulp of the adult's finger maintains greater friction against the annular recessed center portion, and thereby makes it easier for the adult to rotate striker wheel 720. **The lack of pulp on a child's finger prevents the child from contacting annular recessed center portion 719 and therefore makes it more difficult for the child to rotate striker wheel 720.**

See id. at 5:55-66 (emphasis added). This concept is so critical to the operation of the lighter in Sher that it is expressly recited in the claims:

The lighter of claim 1, wherein said annular recessed center portion has a depth, the depth being of a size such that a child's finger is prevented from contacting and gripping the rough surface of the annular recessed center portion, while the pulp of an adult's finger is allowed to contact and grip the rough surface of the annular recessed center portion.

See id. at 7:1-6.

Thus, whereas the design of the present invention is based on the operating principle of increasing the necessary force to actuate the strike wheel by making the discs approximately the same size as the strike wheel in order to deflect some the force, the design of Sher is based on the operating principle of inhibiting access to the strike wheel by making the discs larger than the strike wheel.

In short, Sher teaches away from the present invention. Therefore, since it would not have been merely a matter of obvious design choice to modify Sher by making the discs have a diameter approximately equal to the strike wheel, the invention of claims 2, 8, and 13 would not have been obvious to one of ordinary skill in the art in view of Sher. For the same reasons, claims 3, 6, 9 and 14 are not obvious over Sher in view of U.S. Patent No. 2,481,195 to Burchett.

CONCLUSION

The Examiner is respectfully requested to reconsider his position in view of the remarks made herein. It is believed that claims 2, 3, 6, 8, 9, 13, and 14 have been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

If any additional fees are required as a result of this amendment, or any credit needs to be made for overpayment of fees, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 500703.

Respectfully submitted,

TROJAN LAW OFFICES
By

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